

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE OFFICE OF PETITIONS**

In re Patent Application of:
Cindy KOHANEK et al.

Application No.: 09/904,425

Confirmation No.: 1776

Filed: July 12, 2001

Art Unit: 2859

For: LINEARITY MEASURING APPARATUS FOR
WAFER ORIENTATION FLAT

Examiner: G. Bradley Bennett

Attorney Docket No.: P37034

SUPPLEMENTAL DECLARATION OF MASAYOSHI SUDA

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

I, MASAYOSHI SUDA, hereby declare and state as follows:

1. I have previously executed a Declaration of Masayoshi Suda (hereinafter "Suda Declaration"), dated January 29, 2009, in connection with the above-identified application, and incorporate by reference the contents of the Suda Declaration in full herein;

2. As previously stated in the Suda Declaration, the foreign docketing system (including the U.S. as one of the "foreign" patent offices) of my firm of the Suda Patent Office (hereinafter "SPO") included application filing date, application number, applicant name(s), invention title, inventor name(s), mailing date of office actions, response dates to office actions, due dates of argument, filing dates of amendments, publication dates,

publication numbers, register dates, register numbers, etc. We used these data in the foreign docketing system to inform our Japanese clients about their foreign patent applications entrusted to our firm;

3. However, our foreign docketing system at the time of mailing of the July 3, 2002 Office Action did not include data about the actual filing date of a response to a foreign office action. Instead, we fully trusted the foreign attorneys to file the response by the due date of a foreign office action, if we sent our instructions to the attorneys in ample time before the due date. As a result, we only required the foreign attorneys to send us an acknowledgement of their receipt of our instructions. Accordingly, we put our emphasis at that time at SPO on providing the foreign attorneys with our instructions before the response due date, rather than on confirming the actual filing date of the response from the foreign attorneys. Of course, we would eventually learn of the actual filing date of the response upon receiving the filed document by airmail from the foreign attorneys;

4. Thus, with respect to foreign prosecution matters during the general timeframe involved with the mailing of the Office Action on July 3, 2002 through about 2007, SPO fully trusted the foreign attorneys to file office action responses by the due dates of the actions, if we sent our instructions in ample time before the due dates;

5. As stated in the Suda Declaration, in the timeframe of about 2007, we slightly modified the SPO docketing system and practices with respect to foreign prosecution matters by adding data to the foreign docketing system concerning the actual filing date of a response to a foreign office action. While our trust and confidence with the foreign attorneys with whom we worked as of that point in time had not changed, the main reason for this slight

modification resulted from some experiences with Mr. Goldberg. In particular, Mr. Goldberg had filed some responses to U.S. PTO office actions with time extensions that were not previously authorized by SPO or its clients. As a result, we began to ask all of our foreign attorneys, including Mr. Goldberg, to inform SPO by facsimile or e-mail immediately upon the actual filing of a response;

6. Our SPO internal procedures were modified even further in that, every Tuesday, my assistant in charge of foreign prosecution matters was required to deliver to all of our other assistants a spreadsheet of the pending patent applications in which PTO office actions were outstanding, along with the actual filing date of responses to the office actions. In this manner, any office action on the spreadsheet that did not have an actual filing date after it would remain on the spreadsheet. As a result, we would hopefully become aware if any foreign attorney had not yet responded to an outstanding office action;

7. Also, as stated in the Suda Declaration, among the many clients of mine for whom Mr. Goldberg performed legal services over the years in many U.S. patent applications was SUMCO Corporation (hereinafter "SUMCO"), as discussed in paragraphs 35 and 37 of the Suda Declaration. Mr. Goldberg was entrusted through me by SUMCO and its patent department (hereinafter "SUMCO IP Department") to handle many IP matters, including the preparation, filing, and prosecution of the specific U.S. patent application at issue here, i.e., Application Serial No. 09/904,425 ("the '425 application"), filed on July 12, 2001 for inventors Cindy Kohanek and Gary Babb, entitled "Linearity Measuring Apparatus for Wafer Orientation Flat;"

8. The '425 application was filed by Mr. Goldberg in the U.S. Patent and Trademark Office (hereinafter "PTO") while he was with Reed Smith;

9. On July 3, 2002, a first Office Action on the merits was mailed from the Patent and Trademark Office setting a three month shortened statutory period for response until October 3, 2002, and to which a response was inextendibly due with payment of extensions of time for three months by January 3, 2003;

10. I received a letter dated July 31, 2002 from Mr. Goldberg indicating that an Office Action has been mailed on July 3, 2002 having a 3-month due date of October 3, 2002 and a 6-month due date of January 3, 2003 which could not be further extended. The letter requested comments and noted that objections are relatively minor and that we should be able to obtain allowance of the application;

11. On or about August 20, 2002, I communicated with the SUMCO IP Department regarding the mailing of an Office Action in connection with the '425 application on July 3, 2002;

12. On or about September 2, 2002, I received instructions from the SUMCO IP Department regarding the Office Action in the '425 application providing instructions for filing a response thereto;

13. I forwarded a letter dated September 12, 2002 to Mr. Goldberg providing instructions for filing and requesting comments from Mr. Goldberg;

14. I forwarded a letter dated September 19, 2002 marked URGENT REMINDER to Mr. Goldberg;

15. I forwarded a letter dated September 20, 2002 to Mr. Goldberg requesting a response to my September 12, 2009 letter as well as the filing of a petition for a one month extension of time;

16. I received a letter dated September 20, 2002 from Mr. Goldberg suggesting strategy for proceeding with the prosecution of the application, and indicating Mr. Goldberg's desire to discuss the application with the Examiner;

17. I forwarded correspondence to the SUMCO IP Department about the end of September forwarding the September 20, 2002 correspondence from Mr. Goldberg;

18. I forwarded further correspondence on or about October 10, 2002 to the SUMCO IP Department requesting instructions for filing a response;

19. On or about October 16, 2002, I received from the SUMCO IP Department instructions regarding filing a response to the Office Action in the '425 application;

20. I forwarded a letter of instructions dated October 17, 2002 to Mr. Goldberg providing instructions for filing a response to the Office Action in the '425 application;

21. On or about October 17, 2002, I communicated with the SUMCO IP Department the October 17, 2002 letter of instructions forwarded to Mr. Goldberg;

22. I forwarded correspondence dated October 6, 2004 to the SUMCO IP Department regarding payment of invoices in connection with the activities of Mr. Goldberg in connection with the '425 application and, on information and belief, did not associate this invoice with substantive issues regarding the '425 application;

23. As noted above, at the time of the abandonment of the '425 application, SPO did not have any procedure in place to check on the filing of foreign responses, including

responses in U.S. applications, and to check on the taking of timely action by its foreign attorneys, including its U.S. attorneys. Accordingly, once instructions were forwarded to the U.S. attorney, SPO assumed that action was being taken and pendency of the application was being maintained. In fact, the Reed Smith law firm was considered by SPO as a large New York law firm upon which SPO could fully rely upon for prosecution of applications before the PTO;

24. However, as previously stated in this Supplemental Declaration as well as in the Suda Declaration, SPO presently docketed to check that SPO has received confirmation of filing of responses in the PTO and to check that the pendency of U.S. applications is being maintained;

25. In the instant application, SPO never had any intention to abandon the application, and timely provided instructions to Mr. Goldberg to obtain allowance of the application;

26. SPO did not become aware of the abandonment of the '425 application until checking of the status of the application in the manner set forth in the Suda Declaration, and immediately took steps to obtain revival of the application, and to ensure that the SPO docketing system would double check actions by its foreign attorneys.

27. I can once again state unequivocally and without any reservation whatsoever that, during the entire time the '425 application was pending before the PTO, from our perspective, including the time period from the last communications the SUMCO IP Department received by SPO concerning the applications, as mentioned in paragraphs 50 and

51 of the Suda Declaration, until my notification to SUMCO, *infra*, of the abandonments in December 2008, neither I nor SPO intended the '425 application to go abandoned;

28. I can state as well, unequivocally and without any reservation whatsoever that, during the entire time the '425 application was pending before the PTO, from our perspective, including the time period from the last communications the SUMCO IP Department received by SPO concerning the applications, as mentioned in paragraphs 50 and 51 of the Suda Declaration, until my notification to SUMCO, *infra*, of the abandonments in December 2008, neither I nor SPO was informed or had any reason to believe that either SUMCO or the SUMCO IP Department intended either application to go abandoned;

29. As a result of the foregoing, I can state without equivocation or reservation that, during the entire delay in filing the required reply from the due date of the Office Action at issue in the '425 application, until the filing of what I hope is a grantable petition for the '425 application, the abandonment of the application was unintentional;

30. In signing this Declaration, I understand that the Declaration will be filed as evidence in support of a Petition to Revive for the '425 application; and

I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true. I further declare that these statements were made with the knowledge and understanding that willful false statements and the like so made are punishable by fine, or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of any U.S. patents issued from such applications.

Respectfully submitted,

Dated: October 23, 2009 Masayoshi Suda
MASAYOSHI SUDA